

REMARKS

Claims 1, 9, 10 and 16 have been amended. Thus, claims 1-16 are pending in the present application. Support for the claim amendments may be found in the specification at, for example, page 3, lines 17-27 and page 4, lines 11-32. Thus, no new matter has been added. Reconsideration and withdrawal of the present rejections in view of the comments presented herein are respectfully requested.

Rejection under 35 U.S.C. §102(b)

Claims 1-8 and 16 were rejected as being anticipated by Nagashima (US 4,148,968). In order for a claim to be anticipated by a reference, each element of the claim must be found within the reference.

The pending claims relate to a liquid toner composition that has both:

- (1) a fine particulate toner that forms a toner image; and
- (2) a security ingredient, which is retained on the substrate in the event of fraudulent alteration or removal of the toner image.

Nagashima describes a toner composition for use in an imaging process in which an image is produced by the reaction of a first reactant in the toner composition with a second reactant on the substrate. The toner composition includes only a single imaging component, which produces only a single image on the substrate. The toner composition of Nagashima does not produce two images, namely a toner image and a recognisable security feature as recited in the present claims. Thus, the presently claimed invention cannot be anticipated by this reference.

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b).

Rejection under 35 U.S.C. 103(a)

Claims 9-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nagashima (US 4,148,968) as applied to claim 2 above, and further in view of Hsu (US 6,051,305).

The presently claimed invention requires the use of two imaging features produced from each of the fine particulate toner and the security ingredient. Although the two features are produced simultaneously by applying the imaging composition to the substrate, they are entirely

separate from each other and exist on the substrate in different forms. The toner image sits on the surface of the substrate and, although fused to the surface, is subject to removal by, for example, scraping with a scalpel. Thus, the image is vulnerable to fraudulent removal or alteration. In contrast, the security feature is formed within the body of the substrate, and is detectably retained even if the toner image is removed, thus providing protection against fraudulent alteration of documents.

The cited references do not suggest the presently claimed invention. As described above, Nagashima does not teach an imaging composition that includes two separate imaging components. Similarly, Hsu teaches a different imaging composition produced from a single imaging component. According to the Examiner, it “would have been obvious to tone [*sic*] of ordinary skill in the art at the time of the invention to use the liquid toner of Nagashima in any known system, including that of Hsu.” Office Action, ¶ 5. However, such a conclusory statement is insufficient to support a *prima facie* showing of obviousness under the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” published in the Federal Register, Vol. 72, No. 195 at page 57526 (October 10, 2007). According to these guidelines:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . Rejections on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Id. at paragraph bridging pages 57528-57529. The required reasoning has not been provided in connection with the presently outstanding rejection.

One having ordinary skill in the art would have absolutely no reason to combine the disclosures of the Hsu and Nagashima references. Each of the references describes a system that on its own produces a complete toner image. A person having ordinary skill in the art would not be able to identify any reason to combine these teachings, as such a person could not discern any advantage from combining the teachings. In fact, one having ordinary skill in the art would expect there to be disadvantages to combining the systems, as each of the two systems might interfere with the formation of a toner image by the other system.

It is Applicants’ discovery that combining a fine particulate toner that forms a toner image and a security ingredient could lead to the development of security feature that is detectably retained in or on the substrate in the event of fraudulent alteration or removal of the

toner image. Only through knowledge of this discovery would one combine two different imaging systems to produce a liquid toner digital press imaging composition having both of the claimed ingredients. Neither the Hsu nor the Nagashima references disclose any form of security feature or anything else that would provide a reason to create the claimed combination.

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

CONCLUSION

Applicants submit that all claims are in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

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